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EXAMINER

HAYES, BRET C

ART UNIT PAPER NUMBER

3644

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/807,573

Applicant(s)

KUMMERER ET AL.

Examiner

Bret C. Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau. (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of 1 – 11, 15 – 18 and 20 in the reply filed on 15 JUN 05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Merely questioning the rationale of the examiner does not equate to 'distinctly and specifically pointing out supposed errors'. Applicants' argument that the claimed invention is structurally designed for carrying explosives and initiators under potentially combat conditions has been considered but is deemed to be without merit.

2. In response, examiner would like to point out:

A. any alleged 'structural differences' are not being claimed in so much language;

B. "for carrying explosives and initiators under potentially combat conditions" does no more to limit the scope of the claimed invention even were it to be included in the claims themselves than to say "for carrying fresh, hot pizzas and chilled wine". It is merely an intended use and does not structurally distinguish the claimed invention from a "picnic" lunch bag as properly asserted.; and,

C. "potentially" does nothing to exclude anything presented previously.

3. Further, a Non-Final Office Action is not required where the previous prior art of record will anticipate or render unpatentable the claim invention. However, because the examiner has noticed other issues with the claimed invention, and in light of newly found art, such is being granted.

Information Disclosure Statement

4. The information disclosure statement filed 18 MAR 2004 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered. Either no form PTO-1449 was filed with the IDS or the form was not scanned into the application. In any event, examiner again respectfully requests Applicants submit another IDS properly including the form PTO-1449.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1 – 11, 15 – 18 and 20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for potentially containing fragments, does not reasonably provide enablement for fragmentation inhibiting. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to operate the invention commensurate in scope with these claims. There would appear to be no mention within the disclosure addressing how the claimed invention, a pack, would restrain/prohibit/not allow something within from breaking or separating into fragments; but rather, could probably only contain those fragments and perhaps prevent their escape from the pack.

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7. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new matter is 'a material comprising a conductive shield' and 'said back panel comprising...a blast resistant and fragmentation inhibiting shield'. While Applicants have disclosed that the term "conductive" relates to electricity, nothing about the material being a conductive "shield" is disclosed anywhere within the specification. Examiner understands the term shielded in the sense of a cable being a braided shield of strands of copper (or other metal), a non-braided (solid) shield, or a winding of metal tape completely enclosing an insulated cable. However, such is neither disclosed nor claimed. Evidence to the contrary is requested. Applicants have not, however, disclosed any sort of "shield" with respect to blast resistance or fragmentation inhibiting in the generally accepted sense of the word and as set forth above.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1 – 11, 15 – 18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. In claims 1 and 20, the terms "blast resistant" and "fragmentation inhibiting" are relative terms, which render the claims indefinite. The terms "blast resistant" and "fragmentation inhibiting" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably

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apprised of the scope of the invention. The terms “material” and “shield” are made unclear because of the use of the words “blast resistant” and “fragmentation inhibiting”.

Further, claim 1 recites the limitation “a second closure structure”, which is unclear as the claim only recites “a first opening and closure structure” previously. (*Emphasis added.*) Is the second closure structure also an opening structure, similar to the first?

11. In claim 2, the terms “blast resistant”, “fragmentation resistant” and “fragmentation inhibiting” are relative terms, which render the claim indefinite. The terms “blast resistant”, “fragmentation resistant” and “fragmentation inhibiting” are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term “material” is made unclear because of the use of the words “blast resistant”, “fragmentation resistant” and “fragmentation inhibiting”.

Re – pp 10 and 11 above, while the terms would arguably be reasonably apprising to one of ordinary skill in the art, examiner notes that *any* material, such as those used in ‘packs’ as claimed, would be “blast resistant”, “fragmentation resistant” and “fragmentation inhibiting” as set forth in the previous office action. In other words, exactly how blast resistant does blast resistant material (and similarly for fragmentation resistant material and fragmentation inhibiting material) need to be in order to meet the scope of the claims?

12. The term “conductive” in claims 1, 15 and 20 is a relative term, which renders the claim indefinite. The term “conductive” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The terms “material” and “shield” are made

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unclear because of the use of the word conductive. In the world bound by the laws of physics as we understand those laws, there is no perfect electrical conductor. Neither is there a perfect electrical insulator. It is understood that every electrical insulator can be forced to conduct electricity. This is known as dielectric breakdown.

Further, the term “conductive” can relate to at least two types – thermal and electrical conduction – and should be specified within the body of the claims as to the metes and bounds of the term. While the claims are examined in light of the specification, limitations cannot and will not be read into the claims.

13. Some of the terms outlined above would appear to have been used in claims 5, 6, 9, 10, 15 and 18, for example.

14. Any unspecified claim is rejected as being dependent upon a rejected base claim.

Because of the lack of clarity of the claim language, the claims will be examined on the merits *as best can be understood* for the remainder of this office action.

(For brevity, the terms, blast resistant, fragmentation resistant and fragmentation inhibiting, will be shortened to b.r., f.r. and f.i. for the remainder of this office action.)

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,136,119 to Leyland.

17. Re – claims 1 and 20, Leyland discloses the invention as claimed including a pack, best seen in Fig. 1, for example, comprising: a section “1”, such as that in and around elements 57 and 59, for example, comprising a first opening and closure structure, such as elements 20, 56 and 58, for example, to close a first opening, such as the opening plainly visible as in an open state on the leftmost side of Figure 1, for example; a section “2”, such as that in and around elements 51 and 53, for example, comprising: a second opening, such as opposite the plainly visible first opening of Figure 1, for example, a second closure structure, such as elements 18, 50 and 52 for example; a fabric, as set forth at col. 1, lines 65+, for example, comprising at least one layer of conductive material substantially surrounding the section “2”, as set forth at col. 2, around line 35, for example, including a back panel, such as panels 10 and 12, for example, between the section “1” and the section “2”, said back panel comprising said conductive material and at least one layer of b.r. and f.i. material – as best can be understood.

18. Re – claim 16, Leyland further discloses wherein the back panel 12, for example, is substantially parallel to the second closure structure 18, for example.

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19. Re – claim 18, Leyland further discloses wherein the section “1” comprises a portion of b.r. and f.i. material and said conductive material intermediate said first opening and closure structure 20, 56 and 58, for example, and the section “2”. Leyland is clear that between the two “sections” – 1 and 2 – there is material (at least as b.r. and f.i. as any other material and the conductive material as claimed. Therefore, this limitation has been met.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 5, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leyland.

22. Re – claims 5, Leyland discloses the utilization of nylon as a material in the art intended as “electromagnetically shielding plastic material”, as set forth at col. 3, lines 1 – 3, for example. However, Leyland does not disclose two layers of nylon, two layers of b.r. and f.i. material, and one layer of conductive material therebetween. Firstly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to multiply the layers as disclosed by Leyland, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Secondly, the arrangement of the materials relative to each other would be obvious to one of ordinary skill in the art at the time the invention was made, since it has been held that

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rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ

70. In other words, there is no invention in duplicating and rearranging parts of an invention.

23. Re – claim 15, Leyland discloses the invention substantially as claimed except for arrangement of the materials being the b.r. and f.i. being intermediate the conductive material and the section “2”. It would have been obvious to one of ordinary skill in the art at the time the invention was made to so arrange the materials, since, as above, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

24. Re – claim 17, Leyland discloses the invention substantially as claimed except for the arrangement of the back panel to the first opening and closure structure and the second closure structure when closed. As stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to so arrange the structures, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

Additionally, it is noted that the claims are directed to an apparatus per se, not a method of operation.

However, the claim contains a limitation concerning the method/manner of the pack “when closed”.

Note that it is well settled case law that such limitations, which are essentially method limitations or statements of intended or desired use, do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 152 USPQ 235; *In re Otto*, 136 USPQ 458; and, *Ex parte Masham*, 2 USPQ2nd 1647.

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See MPEP 2114, which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of the structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

and,

Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

Allowable Subject Matter

25. Claims 2 – 4 and 6 – 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (571) 272 – 6902. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

On July 15, 2005, the Central FAX Number was changed to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

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Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and 571-273-8300 will be the only facsimile number recognized for "centralized delivery".

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu, can be reached at (571)272 – 7045. The fax number is (703) 872 – 9306.

bh

5-Sep-05



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